

REMARKS

Office action summary. Claims 22-29 and 32-34 are pending in the application. Claims 22-29 and 32-34 are rejected as anticipated by U.S. Patent No. 5,932,113 ("Kurdi"). Claims 22-29 and 32-34 are also rejected as obvious over Kurdi in view of U.S. Patent No. 5,516,430 ("Hussinger").

These rejections are overcome by the amendments made herein and otherwise traversed for the reasons stated below.

Claim amendments. Claims 32 and 34 have been amended and new claims 35-37 added to better define the invention. The existing claim 32 supports the amendment to the claim, since one of two options is being deleted. Support for the amendment to claim 34 is found in paragraph [0079]. Support for claim 35 is found in paragraph [0079]. Support for claim 36 is found in paragraphs [0078] and [0079]. Support for claim 37 is found in paragraph [0078].

Anticipation and obviousness rejections of claim 22.

The Examiner's anticipation rejection of claim 22 is not well taken because what the present applicants have discovered is that within the broad class of silicon-based polymers, there are some which are debondable. It is those debondable silicon-based polymers which are being claimed in claim 22 and claims dependent on it.

The Examiner is in essence saying that the single word "silicones" at the end of a long list in Kurdi (col. 6, line 60) – a list which discloses a number of broad classes of polymers for use as possible encapsulants – teaches the specific class of debondable silicon-based polymers to which claim 22 is limited. This is like saying that a general disclosure of mice discloses a claim to genetically modified mice having a particular mutation. The law is otherwise: a disclosure of millions of possible silicones does not anticipate or render obvious a much smaller class having distinctive properties. *See, e.g., In re Baird*, 16 F.3d 380 (Fed. Cir. 1994) ("A disclosure of millions of compounds [in the prior art reference] does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds."); MPEP § 2144.08 ("The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.") (citing *Baird*); *In re Ruschig*, 343 F.2d 965, 974 (CCPA 1965) (except in a "very special situation," a genus will not anticipate a species within it). Here, as in *Baird*, Kurdi's

preferences lead away from using silicones. In col. 6, lines 63-65, Kurdi describes two encapsulants as preferred, one being a thiolene and the second an acrylic. The person of skill in the art looking at Kurdi would have no more reason to use the particular silicones claimed here than any other silicones or any other polymers within the numerous classes (“curable acrylates . . . , acrylics, epoxys, urethanes, polyethers”) listed in Kurdi col. 6, lines 59-60.

The Examiner here appears to be falling into the well-known “obvious to try” fallacy. “An invention is ‘obvious to try,’” and therefore not truly obvious, “‘where the prior art [gives] either no indication of which parameters [are] critical or no direction as to which of many possible choices is likely to be successful.’” *Merck & Co. v. Biocraft Labs.*, 874 F.2d 804 (Fed. Cir. 1989) (quoting *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988)); *In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990) (“An ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist’s curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result.”). Here, neither Kurdi nor Hussinger give any indication of which of the types of polymers they disclose one would use to achieve ready debondability or of how to achieve that desirable characteristic. This lack of guidance results in a failure of the prior art references, even if combined, to render what is presently claimed obvious.

The Examiner also states: “It is the position of the examiner that because the silicone material used by Kurdi is the same material discussed by applicant, the material is necessarily debondable.” This is not correct because the class of silicones is a broad one, comprising many different polymers having many different kinds of substituents along the backbone, including for example alkyl, aryl, and various classes of functionalized substituents of different lengths. *See, e.g.*, Malcolm P. Stevens, *Polymer chemistry: an introduction* (Oxford University Press: 2nd edition 1990), section 15.1. The members of this class are not one polymer, nor do they all have the same properties. This application does not contend, nor is there any reason to believe, that all the different known silicones are debondable. Only the debondable ones are claimed.

Rejections of dependent claims. The rejection of claims 23-29 and 32-34 is not well taken because those claims are dependent on claim 22.

In addition, it is believed that at least claim 32 as amended, claim 33, claim 34 as amended, and the new claims 35-37 further distinguish patentably over Kurdi and Hussinger.

In particular, the Examiner with respect to claim 33 states that in Kurdi polymerization occurs during the curing of the encapsulant. However, Kurdi does not say that this happens with silicones, since Kurdi mentions silicone encapsulants exactly once, in a long list. "Curing" by itself could just as well refer to crosslinking as to polymerization, so that without a specific disclosure of polymerization of silicones, Kurdi cannot anticipate or render obvious a claim that requires *in situ* polymerization specifically of silicon-based polymers. Hussinger does not cure this deficiency since it does not mention silicones.

Likewise, it is not believed that Kurdi or Hussinger disclose what is recited in claims 32 and 34 as amended, or in new claims 35-37. For example, with respect to claims 35 and 36, the word "catalyst" does not occur at all in Kurdi.

CONCLUSION

As a result of the amendments, the presently pending claims are believed to be allowable. If the Examiner has any questions concerning this response to the outstanding Office Action and the amended claims provided, he is welcome to contact the undersigned attorney at (650) 251-7712.

Respectfully submitted,

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Date: March 19, 2007